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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,289	01/17/2002	Stephen O. Clark	45715.830001.000	4897
26582	7590	05/20/2004	EXAMINER	
HOLLAND & HART, LLP 555 17TH STREET, SUITE 3200 DENVER, CO 80201			ARYANPOUR, MITRA	
			ART UNIT	PAPER NUMBER

3711

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/053,289	<b>Applicant(s)</b> CLARK ET AL.	
	<b>Examiner</b> Mitra Aryanpour	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 1-12 are objected to because of the following informalities: in claim 1, line 4, "of" should be deleted after "diameter". Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The drawings (see figure 4) and the specification (see page 6 of the specification) do not provide support for the limitation of claim 17, since claim 17 is dependent on amended claim 13 which require the means for simulating to have an outer diameter of about 6 inches and about 7 inches and claim 16, which requires the means for simulating to be the means for deadening the impact. The specification does not provide support for the foam or rubber sleeve to be about 6 inches and about 7 inches. It appears that perhaps the means for attaching the simulating means is a foam or rubber sleeve.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed geometrical shapes rectangle, square, triangle and trapezoid render the claim indefinite, since these geometrical shapes do not have an outer diameter as required by claim 1. Applicant has not shown or defined in this application as originally filed what distance is intended to encompass the outer diameter in the aforementioned geometrical shapes.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Genjack (3,169,019).

Regarding claim 1, Genjack shows at least one cup (11); at least one strap (30) attached to the cup (11), wherein the strap is adapted to secure the cup to the bat (25). Genjack is silent as to the material used to make the cup (11). However, referring to figures 4 and 6, the symbol (shading) used to indicate the cross section of the cup, suggests that the material is a synthetic resin or plastic. As it is well known both material have some degree of resiliency. The degree of resiliency varies depending on the shore hardness of the material. Genjack does not disclose expressly the at least one cup having an outer diameter of about 6 inches and about 7 inches. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the at least one cup having an outer diameter of about 6

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inches and about 7 inches, because Applicant has not disclosed that forming the at least one cup having an outer diameter of about 6 inches and about 7 inches, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cup taught by Genjack or the claimed cup having an outer diameter of about 6 inches and about 7 inches because both cups perform the same function of catching and throwing a ball. Therefore, it would have been an obvious matter of design choice to modify Genjack to obtain the invention as specified in claim 1.

Regarding claim 2, Genjack shows the strap is detachably coupled to the at least one cup (see column 2, lines 12-35); and a length sufficient to wrap around the barrel (see figure 1).

Regarding claim 3, Genjack shows the strap to be a continuous loop. Official Notice is taken that modifying a continuous loop strap (one-piece) to a two-part strap would have been an obvious choice of design and it would have been obvious to do so here, since it would make the device more readily detachable.

Regarding claim 4, Genjack further shows the cup (11) is positionable along the bat (25). See figure 1.

Regarding claim 5, Genjack further shows the cup (11) having a seating surface (20) adapted to be secured adjacent to the bat (25), and sidewalls (13) having a rim, wherein the rim defines an opening (see figures 2 and 6).

Regarding claim 6, Genjack further shows the sidewalls (13) tapering generally outwardly (see figure 4).

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Regarding claim 7, Genjack shows the seating surface having a substantially funnel shape (see figure 2).

Regarding claims 8 and 9, Genjack also show the opening defining a geometrical shape such as a circle (see figure 2).

Regarding claim 10, Genjack shows the seating (20) having an opening (33).

Regarding claim 11, as best seen from figures 2 and 3, Genjack shows the cup having a rim and the rim having a lip portion which has an outer, inner and transition portion and generally parallel to the bat surface (see figure 1).

Regarding claim 12, Genjack is silent with regards to the material used to form the cup (11). However, referring to figures 4 and 6, the symbol (shading) used to indicate the cross section of the cup, suggests that the material is a synthetic resin or plastic. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the at least one cup of rubber, foam, leather, etc. material, because Applicant has not disclosed that forming the cup of rubber, foam, leather, etc. material, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the material taught by Genjack or the claimed material(s) because both material perform the same function of forming a cup for catching and throwing a ball. Therefore, it would have been an obvious matter of design choice to modify Genjack to obtain the invention as specified in claim 12.

Regarding claim 13, note the rejection of claim 1.

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Regarding claim 14, Genjack further shows the device to be used for catching a ball, which the user would guide or direct the bat towards the incoming ball (see column 1, lines 14-16).

Regarding claim 15, note the rejection of claim 4.

Regarding claim 16, Genjack's cup upon catching or impacting a ball would inherently deaden the impact of the ball on the bat.

Regarding claim 17, as best the claim is understood and inasmuch as applicant has defined the means for simulating to be a foam or rubber sleeve, Genjack also shows the means for simulating (11) is attached to the bat (25) using an elastic band (30; the broadest reasonable interpretation of sleeve would include elastic band 30). Both foam and rubber are elastic material.

Regarding claim 18, note the rejection of claim 1. Additionally, Genjack shows the cup being attached to a bat (see figure 1), wherein the bat has a handle portion, a barrel portion and an intermediate portion.

Regarding claim 19, Genjack shows the cup or bunt aid (11) to be releasably attached to the bat. It would have been obvious to one of ordinary skill in the art to have made the cup integral with the bat, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *In re Larson* 144 USPQ 347 (CCPA 1965), and it would have been obvious to do so here, the motivation being it would require less parts, ultimately producing a more cost effective assembly.

Regarding claim 20, note the rejection of claim 2.

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Regarding claim 21, note the rejection of claim 12.

***Response to Arguments***

8. Applicant's arguments filed 20 February 2004 have been fully considered but they are not persuasive. The amendment to the claims submitted on 20 February 2004 has overcome the 112<sup>1st</sup> rejection. With regards to applicant's remarks to the recitation of a Markush Group in the independent claims 1, 13 and 18, The term "about" conveys that the diameter is almost the same as; close to; near or approximately 6" or 7". Therefore, the diameter could hypothetically be 3", 5" or 7.5" both can be considered as "about" 6" or 7", since applicant has not set any specific range as to what is intended of about 6" or 7". As applicant has indicated the outer diameter of 6 inches for a baseball and about 7 inches for a softball is in a preferred embodiment. Per applicant's admission any dimensional configuration is possible (see page 5, 2<sup>nd</sup> paragraph of the specification as originally filed). Therefore, because Applicant has not disclosed that forming the outer diameter of about 6 inches and about 7 inches, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, would have expected Applicant's invention to perform equally well with almost any dimensional configuration. With regards to applicant's remark regarding the resiliency of the bunt aid is acknowledged. However, applicant's has the degree of resiliency has not been claimed. Applicant is merely claiming a cup constructed of a variety of different materials, which appear to have a broad range of resiliency.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Madsen; Talbot; Cavaliere; Kauffman et al; Glintz; Watkin; King; Conture.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MITRA ARYANPOUR  
PATENT EXAMINER

MA  
12 May 2004